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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,928

Applicant(s)

SCHWALB, EDDIE M.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-17, 19 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-17, 19, 29-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 7/17/2006. Claims **1-5, 8-17, 19, 29-38** are pending. Claims **1, 4, 8, 9, 15** are amended. Claims **6, 7, 18, 20-28** have been cancelled. Claims **29-38** are new.

Response to Arguments

1. Applicant's arguments with respect to claims **1, 9, and 15**, filed 7/17/2006, have been considered, but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1, 4, 5, 8, 9, 12-15, 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Stettner.

Referring to claims **1, 9, 15, and 19**, Stettner discloses a software appliance apparatus/method/product for locally enhancing a remote programming broadcast comprising:

- a central processing unit (inherent to set top box (STB) 152)(Fig. 1);

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- a receiver coupled to said central processing unit for receiving said programming broadcast from a remote service provider (originating broadcaster 104)(p. 2, paragraph 24);
- a local memory device electrically coupled to said central processing unit (p. 5, paragraph 52);
- a data structure contained and stored on said memory device, said data structure configured to locally enhance said programming broadcast with a local service that provides at least one of (i) content and (ii) functionality to said programming broadcast, wherein said local service is provided by a local service provider without notification to the remote service provider and wherein said local service bypasses said remote service provider and bypasses a distribution system used for said remote programming broadcast (the examiner notes that the local studio 106 or other party inserts an interactive advertisement into the transmission. The STB 152 receives and displays the advertisement 402, including a visual indicator 404 to indicate the availability of enhanced content)(p. 2, paragraph 22; p. 3, paragraph 32; p. 4, paragraph 35; p. 5, paragraphs 50, 51; & Figs. 1, 4, 5);
- a connection coupled to said central processing unit to provide said remote programming broadcast and said local service for rendering on a local television display 154 (p. 2, paragraph 24); and
- a monitoring and billing module, coupled to the memory device, to monitor activity of said local service and to transmit a record of the activity to a third party so as to permit billing a recipient based on the activity monitored (the customer presses the

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buy button, which initiates the customer's response to the advertisement by requesting fulfillment of the response. The merchant is then connected to the user customer to fulfill the response)(p. 5, paragraphs 50, 51).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Further referring to claim 9, Stettner discloses transmitting a request to a remote billing server for use of said local service, said billing server being provided by and controlled by said local service provider (p. 2, paragraph 20 & p. 4, paragraph 44).

Referring to claims 4 and 12, Stettner discloses the software appliance apparatus/method according to claims 1 and 9, respectively, further comprising a reader, coupled to the central processing unit, to read content on said local memory device and to transmit it as at least part of said local service (p. 5, paragraph 52).

Referring to claim 5, Stettner discloses the software appliance apparatus according to claim 1, wherein the software appliance apparatus further comprises a connector configured to receive a personal digital assistant (PDA) or a computer device (p. 5, paragraphs 46, 47).

Referring to claim 8, Stettner discloses the software appliance apparatus according to claim 1, wherein said software appliance apparatus is configured to reside within a set top box (this limitation is met by the citations noted above with respect to claim 1).

Referring to claims 13 and 14, Stettner discloses the method according to claim 9, further comprising the step of remotely monitoring usage of the local service and the step of billing for the use of the local service (these limitations are met by the citations noted above regarding claims 1 and 9).

3. Claims **29-31, 38** are rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty et al.

Referring to claim **29**, Dougherty et al. discloses a method for providing access to local software applications on a programming broadcast independently of the programming broadcast service provider, the method comprising:

- providing a first programming broadcast from a remote service provider on a remote broadcast distribution system (col. 7, l. 4-41 & Fig. 3);
- providing a software appliance (consumer premise equipment CPE 350) connected to the remote broadcast distribution system and configured to receive the first programming broadcast, comprising:
 - o an input signal receiver and an input signal demodulator and decoder (col. 13, l. 59-60 & Fig. 2);
 - o a computer-readable media (first storage device 212)(col. 14, l. 36-40) containing a local service provided by a local service provider without notification to the remote service provider (col. 18, l. 5-67 & Fig. 4), the local service being a local software application and providing one of (i) content and (ii) functionality to the first programming broadcast (col. 6, l. 6-24); and
 - o an output signal encoder and modulator (inherent to CPE);
- receiving the first programming broadcast at the software appliance (see citations above);

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- adding the local service to the first programming broadcast with the software appliance, wherein the addition of the local service bypasses the remote service provider (col. 6, l. 6-24); and
- generating a second programming broadcast at the output signal encoder and modulator, the second programming broadcast containing the first programming broadcast and the local service (col. 6, l. 20-22).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **30**, Dougherty et al. discloses the method of claim 29, wherein the steps of adding the local service to the first programming broadcast bypassing the remote service provider and generating the second programming broadcast comprise the steps of:

- demodulating and decoding the first programming broadcast (see citations regarding claim 29);
- injecting the local service into the first programming broadcast (col. 6, l. 20-22 & col. 15, l. 35-50);
- encoding and modulating the first programming broadcast and the local service to form the second programming broadcast (col. 6, l. 20-22 & col. 15, l. 35-50).

Referring to claim **31**, Dougherty et al. discloses the method of claim 29, wherein the local service comprises a service selected from the group of:

- a broadcast filtering service;
- a personal computer replacement;
- a display enhancing device for PDAs and computers;

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- a third programming broadcast that includes channels and services to be added to the first programming broadcast;
- a local advertisement;
- pay-per-view games;
- pay-per-view movies;
- check-out services from a hotel; and
- local software contained on a computer-readable media communicative with the software appliance (see citations regarding claim 29).

NOTE: The USPTO considers the applicant's "selected from the group of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim 38, Dougherty et al. discloses the method of claim 29, wherein the software application is configured to reside within a set-top box (col. 7, l. 12-16).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stettner in view of Brotz et al.

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Referring to claims **2**, **10**, and **16**, Stettner discloses the software appliance apparatus/method/product according to claims 1, 9, and 15, respectively. Stettner does not disclose that the apparatus operates within a Digital TV Application Software Environment (DASE). Brotz et al. discloses digital television system in which the DASE signal format can be used (p. 3, paragraph 25). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Stettner to include the ability to use the DASE signal format, such as that taught by Brotz et al. in order to provide a system that can take advantage of the enhanced ability to access and display digital information within a television system for displaying and accessing HTML documents (Brotz et al. p. 1, paragraph 7).

3. Claims **3**, **17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stettner in view of Connelly.

Referring to claims **3** and **17**, Stettner discloses the software appliance apparatus of claims 1 and 15, respectively. Stettner does not disclose that the data structure is Program and System Information Protocol ("PSIP") compatible. Connelly discloses receiving data in PSIP format (p. 2, paragraph 11). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Stettner to include the ability to receive data in PSIP format such as that taught by Connelly in order to help a user locate broadcasted channels.

4. Claim **11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Stettner in view of Connelly and further in view of Pekowsky et al.

Referring to claim **11**, Stettner discloses the method according to claim 9. Stettner does not disclose that the data structure is PSIP compatible. Connelly discloses receiving and storing data in PSIP format (p. 2, paragraph 11). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Stettner to include the ability to receive data in PSIP format, such as that taught by Connelly in order to help a user locate broadcasted channels. The combination of Stettner and Connelly does not disclose collecting Digital Storage Media Command and Control (DSMCC) data from a programming broadcast into a local Program and System Information Protocol ("PSIP") database. Pekowsky et al. discloses playing out PSI and SI information in the form of an EPG, so as to convey the names and descriptions of DSMCC data carousel applications to a user (p. 834, col. 2, l. 11 & p. 835, col. 1, l. 13-18). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the locally stored PSIP data of Connelly in the combination of Stettner and Connelly to include storing DSMCC data carousel application data for representation to a user, such as that taught by Pekowsky et al. in order to inform a user of existing interactive applications.

5. Claim **32, 36-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. in view of Ramsey Catan.

Referring to claim **32**, Dougherty et al. discloses the method of claim 29. Dougherty et al. does not disclose that the software appliance further comprises a monitoring and billing module to monitor activity of the local service, the method further comprising transmitting a request to a remote billing server for use of the local service, the billing server being provided by

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and controlled by the local service provider, wherein the request bypasses the remote service provider. Ramsey Catan discloses delivering an enhanced Ad 62 for an impulse buy of a pizza according to the DASE specification. The consumer presses the “BUY” button 66, which initiates the “acceptance of the offer” and sends a message to the response network 63. The response network then unlocks and delivers further info to the screen (p. 3, paragraphs 35-38). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Dougherty et al. to include charging a user to access further information on an enhanced ad, such as that taught by Ramsey Catan in order to appropriately compensate an advertiser.

Referring to claims 36 and 37, Dougherty et al. discloses the method of claim 29. Dougherty et al. does not disclose the step of remotely monitoring the usage of the local service. Dougherty et al. further does not disclose billing for the use of the local service. Ramsey Catan discloses sending a message to a response network 63 when a user presses a “BUY” button 66. The response network then unlocks and delivers further info to the screen (p. 3, paragraphs 35-38). After choosing a pizza, the user is billed and the pizza company is paid (p. 3, paragraphs 39, 42-44). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Dougherty et al. to include notifying a response network 63 before allowing a user to order a product and to include billing a user for the product, such as that taught by Ramsey Catan in order to appropriately compensate an advertiser.

6. Claims 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. in view of Ramsey Catan and further in view of Sitnik.

Referring to claims **33** and **34**, Dougherty et al. discloses the method of claim 29. The combination of Dougherty et al. and Ramsey Catan teaches the method of claim 32. The combination of Dougherty et al. and Ramsey Catan does not teach that the software appliance is one of a plurality of software appliances, so that one software appliance is a first software appliance and another software appliance is a second software appliance, and wherein the second programming broadcast of the first software appliance serves as the first programming broadcast of the second software appliance, thus forming a flexible programming and billing tree. Sitnik discloses allowing a TV to request a content sample for multiple frames of the currently viewed content of a second TV (p. 2, paragraphs 16, 21). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Dougherty et al. and Ramsey Catan to include transmitting currently viewed information from one television to another television, such as that taught by Sitnik in order to allow a viewer of one television to view the content shown on a second television (p. 1, paragraph 5).

7. Claim **35** is rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. in view of Brotz et al.

Referring to claim **35**, Dougherty et al. discloses the method of claim 29. Dougherty et al. does not disclose that the apparatus operates within a Digital TV Application Software Environment (DASE). Brotz et al. discloses digital television system in which the DASE signal format can be used (p. 3, paragraph 25). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Dougherty et al. to include the ability to use the DASE signal format, such as that taught by Brotz et al. in order to provide a system that

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can take advantage of the enhanced ability to access and display digital information within a television system for displaying and accessing HTML documents (Brotz et al. p. 1, paragraph 7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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